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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,505	03/08/2001	Seigo Kotani	1405.1036	2180

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EXAMINER	
SIMITOSKI, MICHAEL J	
ART UNIT	**PAPER NUMBER**
2134	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/800,505	KOTANI ET AL.	
	Examiner	Art Unit	
	Michael J Simitoski	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The response of 9/8/04 was received and considered.

2. Claims 1-26 are pending.

Response to Arguments

3. In light of applicant's amendments to the claims and specification, the objection to the drawings, objection to the abstract, objection to the specification, objection to claim 5, rejections under 112 ¶1 (claims 18-26) and rejections under 112 ¶2 (claims 1-17) set forth in the previous Office Action are withdrawn.

4. Applicant's arguments filed 9/8/04 have been fully considered but they are not persuasive.

5. On p. 13 of applicant's response (¶3 & ¶6), applicant asserts that the art of record does not teach "deriving encrypted predetermined information outside said predetermined area". However, Hasebe discloses deriving the permissions information in the vendor computer (Fig. 2).

6. On p. 14 (¶6), applicant asserts that the art of record does not teach "predetermined information deriving means encrypting predetermined information stored in said secure area using said medium-specific information or a key generated therefrom and deriving the same outside said secure area". However, Hasebe discloses encrypting predetermined information using a medium-specific information or key generated therefrom and deriving the same outside an area. Shear teaches that keys can be contained in a hidden area on a disc, not normally

accessible so that an attempt to copy the disc would not copy the keys (page 15, ¶218). Shear uses a secure area for storing keys not accessible to the applications, but accessible to authorized components of the system, while Hasebe discloses customizing permissions based on the particular storage medium.

7. On p. 14 (¶7), applicant asserts that the art of record does not teach the following element of claim 22: "decrypting encrypted license information stored in said user-use area using information specific to said apparatus or a key generated therefrom and said storage medium not normally accessible through typical medium-specific information or a key generated therefrom and updating license information stored in said secure area". The underlined portion of applicant's response does not appear in the quoted claim and will be disregarded. Claim 22 recites "decrypting encrypted license information stored in said user-use area using information specific to said apparatus or a key generated therefrom and said medium-specific information or a key generated therefrom and updating license information stored in said secure area". However, Hasebe discloses decrypting encrypted license information/permissions information stored in a user-use area using information specific to the medium or key generated therefrom. Shear is cited for teaching using keys to protect 'metadata' that is used to determine access properties to 'property' on a storage medium (Fig. 3). The keys on the storage medium are encrypted with a key(s) specific to the apparatus so the keys in the encrypted key block are not exposed (Fig. 3 & p. 15 ¶219).

8. On p. 15, ¶1, applicant asserts that the art of record does not teach "decrypting encrypted license information stored in said user-use area using information specific to said apparatus". However, Shear is cited for teaching using keys to protect 'metadata' that is used to determine

access properties to 'property' on a storage medium (Fig. 3). The keys on the storage medium are encrypted with a key(s) specific to the apparatus so the keys in the encrypted key block are not exposed (Fig. 3 & p. 15 ¶219).

9. On p. 15, ¶2, applicant asserts that the art of record does not teach "predetermined information deriving means using said medium-specific information". However, Hasebe discloses deriving predetermined information/permissions information using medium-specific information (medium number) (Fig. 1).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 1 recites the limitation "said medium-specific information" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 2 & 11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,392,351 to Hasebe et al. (Hasebe).

Regarding claim 1, Hasebe discloses encrypting predetermined information/permission information (Fig. 2 #13 & col. 4, lines 9-30) that is stored in a predetermined area (Fig. 2) of a recording medium/storage medium using medium-specific information/medium number (Fig. 2 #12) or a key generated therefrom (Fig. 2 #21 & col. 4, lines 9-30) and deriving said encrypted predetermined information/permission information outside said predetermined area/user computer (Fig. 2).

Regarding claim 2, Hasebe discloses a first area storing said predetermined information/permission information and a second area different from said first area (Fig. 2 #13-14).

Regarding claim 11, Hasebe discloses said encrypted predetermined information/permission information stored on a second recording medium/permission information storage medium different from said recording medium/software storage medium (Fig. 13).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 3-7, 9, 13, 18, 19, 21, 23 & 25, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe in view of U.S. Patent Application Publication 2001/0042043 to Shear et al. (Shear).

Regarding claim 3, Hasebe discloses a system, as described above, with a user-user area (Fig. 2 #14 & Fig. 12) but lacks the first area being a secure area not subject to control by external instructions. However, Shear teaches that keys can be contained in a hidden area on a disc, not normally accessible so that an attempt to copy the disc would not copy the keys (page 15, ¶218). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a secure area for storing predetermined information, the secure area not subject to control by external instructions. One of ordinary skill in the art would have been motivated to perform such a modification to prevent copying of the predetermined information, as taught by Shear (page 15, ¶218).

Regarding claim 4, Hasebe, as modified above, discloses encrypted electronic data stored in the second area (Fig. 2 #14) and predetermined information/permissions information stored in the first area (col. 5 lines 31-39).

Regarding claim 5, Hasebe discloses the predetermined information/permission information (Fig. 2 #13) being stored in a said first area (Fig. 2) of a recording medium/storage medium and encrypted using said medium-specific information/medium number (Fig. 2 #12) or a key generated therefrom (Fig. 2 #21) and the encrypted information/permission information is stored in a predetermined area (Fig. 2).

Regarding claims 6 & 9, Hasebe discloses a system, as described above (Fig. 13 & col. 10 lines 50-59), but lacks encrypting the predetermined information/permission information with

information specific to an apparatus that drives the second recording medium (or a key generated therefrom). However, Shear teaches using keys to protect 'metadata' that is used to determine access properties to 'property' on a storage medium (Fig. 3). The keys on the storage medium are encrypted with a key(s) specific to the apparatus so the keys in the encrypted key block are not exposed (Fig. 3 & page 15 ¶219). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the predetermined information with a key specific to the driving apparatus. One of ordinary skill in the art would have been motivated to perform such a modification to prevent keys/data from being exposed, as taught by Shear (Fig. 3 & page 15 ¶219).

Regarding claim 7, Hasebe discloses a system, as modified above, where the encrypted predetermined information/permission information is stored in said second area (Fig. 2).

Regarding claims 13, 21, 25 & 26, Hasebe discloses a system, as described above (Fig. 13 & col. 10 lines 50-59), but lacks further encrypting the predetermined information/permission information with information specific to an apparatus that drives the second recording medium (or a key generated therefrom). Regarding claim 26, Hasebe discloses a second recording medium (Fig. 13). However, Shear teaches using keys to protect 'metadata' that is used to determine access properties to 'property' on a storage medium (Fig. 3). The keys on the storage medium are encrypted with a key(s) specific to the apparatus so the keys in the encrypted key block are not exposed (Fig. 3 & page 15 ¶219). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further encrypt the predetermined information with a key specific to the driving apparatus. One of ordinary skill in

the art would have been motivated to perform such a modification to prevent keys/data from being exposed, as taught by Shear (Fig. 3 & page 15 ¶219).

Regarding claim 18, Hasebe discloses an apparatus/vendor computer (Fig. 2) with a stored medium with medium-specific information/medium number (Fig. 2 #12) and comprising a user-use area allowing reading out of information/permission information (Fig. 2), the apparatus/computer managing information of a recording medium wherein license information/permission information based on use rights for any information stored in a user-user area is stored in a secure area (Fig. 2) and write and read out means/vendor computer and user computer transferring information to and from a user-user area predetermined information deriving means/vendor computer for encrypting predetermined information/permission information (Fig. 7A) stored in the secure area with medium-specific/medium number information or a key generated therefrom and deriving the same outside the secure area (Fig. 2, #13, 22 & 23). Hasebe further discloses reading/user computer and writing means/vendor computer (Fig. 2) to read and write to the user-use area and encrypting permission information with medium-specific information/medium number (Fig. 2 #12, 21, 23, 22 & 13). Hasebe lacks a secure area not subject to control by external instructions. However, Shear teaches that keys can be contained in a hidden area on a disc, not normally accessible so that an attempt to copy the disc would not copy the keys (page 15, ¶218). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include predetermined information deriving means encrypting predetermined information stored in a secure area not subject to control by external instructions. One of ordinary skill in the art would have been

motivated to perform such a modification to prevent copying of the predetermined information, as taught by Shear (page 15, ¶218).

Regarding claim 19, Hasebe discloses storing encrypted license information/permission information in a user-use area (Fig. 2 # 13 & Fig. 12)

Regarding claim 23, Hasebe discloses transferring the license information stored in medium 1 to another user (col. 5 lines 3-16 & col. 11 lines 20-33). Hasebe does not explicitly disclose transferring to another medium (although it is implied in that licensing information is stored on a storage medium and therefore the transfer of licensing information to another user would imply transferring it to another medium), however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer the information to another storage medium. One of ordinary skill in the art would have been motivated to perform such a modification to transfer the information to another users storage medium to transfer privileges, as was well known in the art at the time the invention was made.

17. Claims 12 & 15, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe in view of U.S. Patent 5,191,611 to Lang.

Regarding claim 12, Hasebe discloses a system, as described above, but lacks updating the predetermined information/permission information. However, Lang teaches that to authorize a user a specific number of information retrievals, a personal access device (PAD) can receive an update command reflecting the users' updated privileges (col. 12 lines 36-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the updating of the predetermined information. One of ordinary skill in the art

would have been motivated to perform such a modification to limit data retrievals by users, as taught by Lang (col. 12 lines 36-58). Further, it is inherent, based on the key(s) used for encryption, that decryption will use the same key(s).

Regarding claim 15, Hasebe discloses a system, as described above, but lacks the medium-specific information/medium number being visually displayed on the recording medium. However, Lang teaches that by displaying information visually on a device for controlling access to data, a user can manually enter the data into another device (col. 6 lines 55-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to visually display the medium-specific information/medium number on the recording medium. One of ordinary skill in the art would have been motivated to perform such a modification to allow for manual entry of the medium-number into another device, as taught by Lang (col. 6 lines 55-59).

18. Claims 8, 10, 14, 16, 17, 20, 22 & 24, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe in view of Shear, as applied to claims 7 & 13 above, in further view of Lang.

Regarding claims 8, 10, 14, 17, 20, 22 & 24, Hasebe discloses a system, as modified above, but lacks updating the predetermined information/permission information. However, Lang teaches that to authorize a user a specific number of information retrievals, a personal access device (PAD) can receive an update command reflecting the users' updated privileges (col. 12 lines 36-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the updating of the predetermined information

stored in the predetermined/first area or secure area. One of ordinary skill in the art would have been motivated to perform such a modification to limit data retrievals by users, as taught by Lang (col. 12 lines 36-58). Further, it is inherent, based on the key(s) used for encryption, that decryption will use the same key(s).

Regarding claims 16 & 17, Hasebe discloses a system, as modified above, but lacks the apparatus-specific information being visually displayed on the apparatus. However, Lang teaches that by displaying information/code visually on a device/smart card for controlling access to data, a user can manually enter the data into another device (for key generation and challenge-response identification) (col. 6 lines 55-59 & col. 7 lines 44-65). Lang further discloses electronic transmission from the smartcard to another device such as a reader (col. 12 lines 53-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to visually display the information specific to an apparatus on the apparatus. One of ordinary skill in the art would have been motivated to perform such a modification to allow for user access to the apparatus-specific information for entry into another device to derive a key or entertain challenge-response identification, as taught by Lang (col. 6 lines 55-59 & col. 7 lines 44-65).

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. – 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached at (571) 272-3838.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, DC 20231
Or faxed to:
(703)746-7239 (for formal communications intended for entry)
Or:
(571)273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJS
November 29, 2004

GREGORY MORSE
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